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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/208,619	12/08/98	HILLMAN J	PF-0229-1DIV

HM22/0306

LEGAL DEPARTMENT
INCYTE GENOMICS, INC.
3160 POPTTER DRIVE
PALO ALTO CA 94304

EXAMINER	
HARRIS, A	
ART UNIT	**PAPER NUMBER**
1642	14

DATE MAILED: 03/06/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Advisory Action

Application No.	Applicant(s)
09/208,619	Hillman And Goli
Examiner	**Group Art Unit**
Alana M. Harris, Ph. D.	1642

THE PERIOD FOR RESPONSE: [check only a) or b)]

a) ☐ expires _____ months from the mailing date of the final rejection.

b) ☒ expires either three months from the mailing date of the final rejection, or on the mailing date of this Advisory Action, whichever is later. In no event, however, will the statutory period for the response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date of the originally set shortened statutory period for response or as set forth in b) above.

☐ Appellant's Brief is due two months from the date of the Notice of Appeal filed on _____ (or within any period for response set forth above, whichever is later). See 37 CFR 1.191(d) and 37 CFR 1.192(a).

Applicant's response to the final rejection, filed on *Feb 20, 2001* **has been considered with the following effect, but is NOT deemed to place the application in condition for allowance:**

☒ The proposed amendment(s):

☒ will be entered upon filing of a Notice of Appeal and an Appeal Brief.

☐ will not be entered because:

☐ they raise new issues that would require further consideration and/or search. (See note below).

☐ they raise the issue of new matter. (See note below).

☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.

☐ they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: _____

☒ Applicant's response has overcome the following rejection(s):
Applicants' amendments and arguments have overcome the following rejections: claims 32 & 33 under 35 U.S.C. 112, 1st and 2nd paragraph and claims 17 & 18 under 35 U.S.C. 101 and 112, 1st paragraph.

☐ Newly proposed or amended claims _____ would be allowable if submitted in a separate, timely filed amendment cancelling the non-allowable claims.

☐ The affidavit, exhibit or request for reconsideration has been considered but does NOT place the application in condition for allowance because:

_____

☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

☒ For purposes of Appeal, the status of the claims is as follows (see attached written explanation, if any):

Claims allowed: —

Claims objected to: *33*

Claims rejected: *17, 18, and 32*

☐ The proposed drawing correction filed on _____ ☐ has ☐ has not been approved by the Examiner.

☐ Note the attached Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☒ Other *Please see the attached addendum to this advisory action.*

SHEELA HUFF
PRIMARY EXAMINER

Addendum to Advisory Action

1. Applicant's arguments do not overcome the listed rejections stated in Paper number 12, mailed December 15, 2000.

(A) The rejection of claims 17 and 18 under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention is maintained. Applicants argue that "...the claims are directed to ...more limited, well defined set." and the activities listed in the claims define the classes of claimed fragments. Applicants have yet to define what specific amino acid should be designated as "biologically-active" and "immunologically active" fragments. Applicants have yet to express where the biologically-activity resides in the claimed fragments. And in regards to immunologically acitvity, four amino acids is defined as an epitope, thus immunologically active.

(B) The 102 and 103 rejections listed in the Paper #12 are maintained. Applicants point out that the reference fragments (referenced by the Examiner), derived from yeast MIM17, would be not longer than six amino acid residues and thus would lack the transmembrane domains required for successful insertion into the mitochondrial membrane. These points are not recited in the claims, hence do not absolve the art rejections of claims 17 and 32. Likewise, as stated the Examiner takes the position that this assertion (MIM17 lacking the transmembrane domains) is Applicants' opinion and not an established fact. There is no fact pattern presented by Applicants that the referenced fragments would not inherently retain the activities as listed in the claims. As stated above in section (A) Applicants have yet to express where the biologically-activity resides in the claimed fragments. And in regards to immunologically acitvity, four amino acids is defined

as an epitope, thus immunologically active.

2. Claim 33 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.